

REMARKS**Summary of the Office Action**

In the Office Action, claims 1, 3-5, 7-9, and 12-15 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,145,825 to *Kunihiro et al.*, hereinafter ("*Kunihiro*").

Claims 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2002/20113362 to *Saito, et al.*, hereinafter ("*Saito*").

Claims 1, 3-5, and 12-15 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112, second paragraph.

Summary of the Response to the Office Action

Applicant has cancelled claims 15 without prejudice or disclaimer. Claims 6 and 8 have been amended to expedite prosecution. Claims 1, 4, 7, and 8 have been amended to address certain ambiguities in the claims. Claims 10-11 and 16-22 are withdrawn. Accordingly, claims 1, 3-9, and 12-14 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

In the Office Action, claims 1, 3-5, 7-9, and 12-15 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Applicant respectfully submits that this rejection is respectfully traversed in light of the current amendments to claims 1, 4, 7, and 8 and cancellation of claim 15.

Further, Applicant respectfully submits that the alleged ambiguities in claims 1 and 12 are not existent. Claims 1 and 12 recite that certain portions of the claimed structure “varies according to whether or not folding is performed on sheets stacked on said compiling tray.” It is clear from the claims and the specification that the claimed structure does not include any folding unit, and that folding of sheets is performed outside of the claimed structure before the sheets are received on said compiling tray. Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

All Subject Matter Complies with 35 U.S.C. § 102(b)

Claims 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Kunihiro*. Applicant respectfully traverses the rejection for at least the following reasons.

Applicant respectfully submits that the Office Action has not established that *Kunihiro* anticipates each and every feature of Applicant’s claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claim 6 recites, at least in part, “a longitudinal alignment portion that gives a conveyance force to sheets sequentially supplied to the compiling tray to push the supplied sheets against the longitudinal reference wall, the longitudinal alignment portion being a paddle member.” *Kunihiro* fails to teach or suggest at least these features of claim 6.

The element 6b of *Kunihiro* acts as a longitudinal alignment portion. See Fig. 2 of *Kunihiro*. However this element has a roller shape and *Kunihiro* does not teach or suggest a paddle member that acts as a longitudinal alignment portion. Accordingly, *Kunihiro* fails to teach or suggest each and every feature of claim 6 and the rejection of claims 6-9 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Kunihiro* does not teach or suggest each feature of newly amended independent claim 6.

Additionally, Applicant respectfully submits that dependent claims 7-9 are also allowable insofar as they recite the patentable combinations of features recited in claim 6, as well as reciting additional features that further distinguish over the applied prior art.

Claims 6-9 also stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Saito*. Applicant respectfully traverses the rejection for at least the following reasons.

Applicant respectfully submits that the Office Action has not established that *Saito* anticipates each and every feature of Applicant's claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Newly amended independent claim 6 recites, at least in part, "a longitudinal alignment portion that gives a conveyance force to sheets sequentially supplied to the compiling tray to push the supplied sheets against the longitudinal reference wall, the longitudinal alignment portion being a paddle member." *Saito* fails to teach or suggest at least these features of claim 6.

The element 18 of *Saito* acts as a longitudinal alignment portion. See Fig. 3 of *Saito*. However this element has a caterpillar shape and *Saito* does not teach or suggest a paddle member that acts as a longitudinal alignment portion. Accordingly, *Saito* fails to teach or suggest each and every feature of claim 6 and the rejection of claims 6-9 should be withdrawn.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicant respectfully asserts that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *Saito* does not teach or suggest each feature of newly amended independent claim 6.

Additionally, Applicant respectfully submits that dependent claims 7-9 are also allowable insofar as they recite the patentable combinations of features recited in claim 6, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and entry of the amendments to place the application in clear condition for allowance, or in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: February 5, 2007

By: 

David E. Connor
Reg. No. 59,868

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Tel: 202-739-3000
Fax: 202-739-3001